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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Malone et al.

Art Unit: 2811

Serial No.: 10/028,015

Examiner: Gebremariam, Samuel A.

Filed: 21 December 2001

Docket No. TI-29277

For: LOW COST FEATURE TO INDICATE PACKAGE ORIENTATION

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| NAME OF INVENTOR(S): | |
| Malone et al. | |
| TITLE OF INVENTION: Low Cost Feature To Indicate Package Orientation | |
| TI FILE NO.: DEPOSIT ACCT. NO.: | |
| TI-29277 | 20-0668 |
| FAXED: 02/28/2005 DUE: 10/06/2004 ATTY/SECY: CAB:ss | |
| RECEIPT DATE & SERIAL NO.: | |
| Application No.: 10/028,015 Filing Date: 21 December 2001 | |

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REPLY BRIEF UNDER 37 C.F.R. § 41.41

28 February 2005

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|  | <u>28 Feb 2005</u> |
| Charles A. Brill | Date |

Dear Sir:

The following Reply Brief is respectfully submitted in connection with the above-identified application in response to the Final Rejection mailed 8 April 2004, the Advisory Action mailed 25 August 2004, and the Examiner's Answer mailed 28 December 2004. Please charge all required fees, including any extension of time fees, to the deposit account of Texas Instruments Incorporated, Deposit Account No. 20-0668.

ARGUMENT

Response to Examiner's Grouping of the Claims:

The Examiner stated, "The rejection of claims 1-9 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7)."

The applicant respectfully submits, 37 CFR 1.192(c)(7) was removed and reserved effective 13 September 2004. The content of appeal briefs is now governed by 37 CFR 41.37 which does not contain any similar requirement.

Furthermore, should 37 CFR 1.192(c)(7) or similar requirement be found to apply, the Examiner has misstated the effect of 37 CFR 1.192(c)(7), which states (emphasis added):

Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

Thus, the grouping should not apply at all, and if it does apply, then it should only apply within each ground of rejection.

Ground of Rejection 1:

The Examiner, for the first time, stated "Since layer (114) remains visible after the upper portion of the package (104) is placed on it, it can show whether the lower package portion is showing the wrong side up or not."

The problem of determining the orientation of a package is well known in the art and one of ordinary skill in the art would interpret the term "orientation of the substrate" as used in Claim 1 to mean the orientation of the package with respect to the electrical connections, typically with respect to pin 1 of the connections. The specification, from line 7 of page 1 through line 3 of page 2, lines 3-6 of page 5, and lines 12-13 of page 6 clarify the term "orientation."

CONCLUSION

Please charge any fees necessary in connection with the filing of this paper, including any necessary extension of time fees, to Deposit Account No. 20-0668 of Texas Instruments Incorporated.

Respectfully submitted,



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